

**REMARKS**

In response to the Office Action mailed May 12, 2003, claims 61-62 have been newly added. Therefore, claims 47-62 are pending. In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

A. **INFORMATION DISCLOSURE STATEMENT (I.D.S.)**

An I.D.S. is being filed by Applicants on even date. Accordingly, Applicants request that the Examiner consider the cited references and return a signed copy of the Form PTO-1449 for this submission.

B. **REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

Claim 52 stands rejected under 35 U.S.C. §112, first paragraph for allegedly containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner alleges that the Specification does not explicitly disclose a "TCP/IP" network. *See* Office Action, pg. 2, ¶4. Applicants traverse.

While the Specification may not appear to "explicitly" recite a "TCP/IP" network, nor is an explicit recitation necessary, the Specification clearly supports the concept of a TCP/IP network. As defined in Random House Webster's Computer & Internet Dictionary, Third Edition, © 1999 by Phillip E. Margolis, TCP/IP is defined as follows:

Abbreviation for *Transmission Control Protocol/Internet Protocol*, the suite of communications protocols used to connect hosts on the Internet. TCP/IP uses several protocols, the two main ones being TCP and IP. TCP/IP is built into the UNIX operating system *and is used by the Internet, making it the de facto standard for transmitting data over networks. Even network operating systems that have their own protocols, such as Netware, also support TCP/IP.*

*Emphasis Added.*

The Specification provides ample support in the various embodiments disclosed therein for the transmission of data (*e.g.*, user data, incentive data, *etc.*) over Networks (*e.g.*, Internet) between *at least*, for example, coupon issuers, distributors, redemption centers, online service providers, Internet web sites, user computers, *etc.* As such, given that TCP/IP is the “de facto” standard for transmitting data over networks, Applicants submit that it would be apparent to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Accordingly, withdrawal of this rejection is earnestly sought.

C. **REJECTIONS UNDER 35 U.S.C. §103**

Claims 47-51 and 53-60 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 4,882,675 to Nichtberger *et al.* (“Nichtberger”) in view of U.S. Patent No. 5,380,991 to Valencia *et al.* (“Valencia”). Claim 52 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over the combination of Nichtberger and Valencia, further in view of U.S. Patent No. 5,592,378 to Cameron *et al.* (“Cameron”). *See* Office Action, pg. 3, ¶5, and pg. 6, ¶6.

Applicants traverse on *at least* the following grounds:

1. The meaning given to *at least* the term “client system” by the Examiner is inconsistent with the meaning given to the term by those of ordinary skill in the art; and
2. Assuming arguendo that there was a teaching, suggestion, or motivation to combine Nichtberger and Valencia, the rejection would still be improper as the two references, even when combined, fail to teach or suggest all of the claim elements.

1. **The Examiner’s interpretation of “client system” is inconsistent with the meaning given to the term by those of ordinary skill in the art.**

In the Office Action, at ¶5, pgs. 3-4, the Examiner interprets the customer’s special card of Nichtberger to be the client system. The Examiner, conceding that the special card of Nichtberger fails to include a computer processor and associated memory, relies on the smart card of Valencia for these features:

“Nichtberger does not explicitly disclose that the client system includes a computer processor and associated memory. However, Valencia discloses client system including a computer processor and associated memory for storing and processing information related to electronic coupons (col 3, lines 13-20; col 3, lines 44-47). Valencia further discloses that the features of Nichtberger are directly related to the invention disclosed (col 2, lines 15-35). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Valencia’s smart card to Nichtberger’s special card. One would have been motivated to do this because the smart card is an obvious improvement of the special card and allows for broader functionality.”

The Examiner’s interpretation of the customer’s special card of Nichtberger (whether viewed alone - or as modified by Valencia) as a client system is incorrect and inconsistent with

the separate meanings afforded to the terms “client” and “smart card” by those having skill in the art.

As an *exemplary* illustration, Applicants have provided below the separate definitions of “client” and “smart card” as defined in Random House Webster’s Computer & Internet

Dictionary, Third Edition, © 1999 by Phillip E. Margolis:

**CLIENT:**

The client part of a client-server architecture. Typically, a client is an application that runs on a personal computer or workstation and relies on a server to perform some operations. For example, an e-mail client is an application that enables you to send and receive e-mail.

**SMART CARD:**

A small electronic device about the size of a credit card that contains electronic memory, and possibly an embedded integrated circuit (IC). Smart cards containing an IC are sometimes called Integrated Circuit Cards (ICCs).

Smart cards are used for a variety of purposes, including:

- Storing a patient's medical records
- Storing digital cash
- Generating network IDs (similar to a token)

To use a smart card, either to pull information from it or add data to it, you need a smart card reader, a small device into which you insert the smart card.

Accordingly, in view of the widely accepted, separate meanings of client and smart card, the Examiner’s interpretation of a smart card as a “client system” is inconsistent with the meaning given to these terms by those of ordinary skill in the art. As such, the rejection of claims 47-60 is improper and should be withdrawn.

2. Assuming arguendo that there was a teaching, suggestion, or motivation to combine Nichtberger and Valencia, the rejection would still be improper as the two references, even when combined, fail to teach or suggest all of the claim elements.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d. 1438 (Fed. Cir. 1991).

The rejection of independent claims 47 and 57 is improper as there exists no teaching, suggestion, or motivation to modify Nichtberger to include the teachings of Valencia. Assuming arguendo that there was a teaching, suggestion, or motivation to combine the two references, the rejection would still be improper as Nichtberger and Valencia, even when combined, fail to teach or suggest all of the claim elements.

In particular, Nichtberger as modified by Valencia fails to teach or suggest *at least* the claimed features of:

- (a) a client system;

- (b) the first server system being adapted for transmitting an electronic coupon to said client system over said communications channel, and the client system being adapted for storing said electronic coupon in said memory; and
- (c) a second server system connected to said communications channel.

(a) **Nichtberger/Valencia fail to teach a client system.**

As recited above, the Examiner's interpretation of a smart card as a "client system" is inconsistent with the meaning given to these terms by those of ordinary skill in the art. As such, the combination of Nichtberger and Valencia fails to teach or suggest a client system as understood by those of ordinary skill in the art. Thus, the rejection of claims 47-60 is improper and should be withdrawn.

(b) **Nichtberger/Valencia fail to teach the first server system being adapted for transmitting an electronic coupon to said client system over said communications channel, and the client system being adapted for storing said electronic coupon in said memory.**

In the Office Action, at pg. 3, ¶5, the Examiner relies on col. 30, lines 1-6 of Nichtberger as allegedly teaching the features of the first server system being adapted for transmitting an electronic coupon to said client system over said communications channel, and the client system being adapted for storing said electronic coupon in said memory.

Assuming arguendo that the Examiner's interpretation of the smart card as a client is proper, Nichtberger at col. 30, lines 1-6, recites storing "*information regarding coupons selected by a user*" and not storing the electronic coupons per se:

“A still further possibility is that *information regarding the coupons* selected by a customer could be recorded on the customer's special card at the time of coupon selection. The information recorded on the card could then be read directly at the checkout station for redemption and subsequent clearing.” *Emphasis Added.*

As such, because the passage in Nichtberger relied upon by the Examiner does not appear to explicitly teach transmitting an “electronic coupon” to the consumer’s special card/smart card, such that the special card/smart card stores the electronic coupon, the rejection of claims 47-60 is improper and should be withdrawn.

(c) **Nichtberger/Valencia fail to teach a second server system connected to the communications channel.**

Assuming arguendo that the Examiner’s interpretation of the smart card as a client is proper, and that Nichtberger does teach transmitting an electronic coupon to the consumer’s special card/smart card, the rejection of claims 47-60 would still be improper, as the combination of Nichtberger and Valencia fails to disclose a second server system connected to the communications channel.

In particular, with regard to the communications channel, the claim language requires that the first server be adapted for transmitting an electronic coupon to the client system over the communications channel, and that the second server be connected to the communications channel. According to the Office Action, the Examiner appears to rely on the local CDR unit (20) of Nichtberger to be the first server system, and the customer’s special card to be the client system. The Examiner cites various passages of Nichtberger to support this interpretation:

“The local CDR unit 20 presents an electronic display to the customer of the coupons which are available for redemption *after the customer inserts a card as described below into the unit*. The card may include a UPC code which identifies the user and *a magnetic stripe on which information can be recorded*. The customer then selects the coupons which he or she wishes to redeem. The CDR unit 20 records the selection and makes information identifying the customer and the selected coupons available to each of the checkout stations which comprise the checkout system 18 of the supermarket.”

*See Nichtberger, col. 5, lns. 1-16. Emphasis Added.*  
.....

“A still further possibility is that information regarding the coupons selected by a customer *could be recorded on the customer's special card at the time of coupon selection. The information recorded on the card could then be read directly at the checkout station for redemption and subsequent clearing.*”

*See Nichtberger, col. 30, lns. 1-6. Emphasis Added.*

According to the Examiner's interpretation, the claimed feature of the first server being adapted for transmitting an electronic coupon to the client system over the communications channel would have to, in Nichtberger, be the CDR Unit (20) recording an electronic coupon on to the customer's special card when the customer's special card is inserted into CDR unit (20). Following this rationale, the communications channel would then have to be a data bus or other electrical component within the CDR Unit (20) that enables data to be recorded on to the customer's special card when the customer's special card is inserted into CDR unit (20).

Applying the Examiner's interpretation consistently, this communications channel [within CDR Unit (20)] could not be the same communications channel used at the checkout system (18) (which the Examiner appears to rely on to be the second server system) to read



stored information off of the customer's special card -- as checkout system (18) is separate and apart from CDR Unit (20). For at least this reason, the Examiner's interpretation and application of Nichtberger and Valencia is flawed.

For *at least* these reasons, Applicants submit that none of the references cited by the Examiner, either alone or in combination, teach all of the elements of independent claims 47 and 57. Specifically, the addition of Valencia does not cure the deficiencies in the disclosure of Nichtberger articulated above. Accordingly, Applicants further submit that dependent claims 48-56 and 58-60 are allowable because they depend from allowable independent claims, as well as for the further limitations they contain.

D. **NEW CLAIMS 61 & 62**

Newly added claims 61-62 explicitly recite that the client system is a "remote" client system.

E. **INTERFERENCE**

Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action. As such, Applicants request that an interference be declared between the above-identified application, and U.S. Patent No. 6,076,069 to Laor.


**CONCLUSION**

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC

By:

  
Bradford C. Blaise Reg. No. 47,429  
for: James G. Gatto – Reg. No. 32,694

Date: **September 12, 2003**

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO, PC  
12010 Sunset Hills Road  
Suite 900  
Reston, Virginia 20190  
(703) 464-4800 (Telephone)  
(703) 464-4895 (Facsimile)

RES 98885v1